

REMARKS

I. The Restriction Requirement

Claims 1-13 are currently pending in this application. The subject matter of the pending claims was restricted as follows:

- I. Claims 1 and 2, drawn to recombinant hMBPs of molecular weight 1000-1300 kDa;
- II. Claims 3 and 4, drawn to recombinant hMBPs of molecular weight 200-400 kDa;
- III. Claim 7, drawn to a method for producing recombinant hMBPs of molecular weight 1000-1300 kDa involving transforming CHO cells; and
- IV. Claim 8, drawn to a method for producing recombinant hMBPs of molecular weight 200-400 kDa involving transforming CHO cells.

II. Election and Traversal

The Examiner alleged that the claims pending in the above-identified application were directed to four distinct inventions and required restriction under 35 U.S.C. §121. Applicant hereby elects Group III (claim 7) with traverse, "drawn to a method for producing recombinant hMBPs of molecular weight 1000-1300 kDa involving transforming CHO cells." (Office Action at p. 2)

The Examiner stated that "Claims 6, 10 and 11 are linking claims and would be joined with one of inventions III and IV, if elected. Claim 9, drawn to a method of making a combination product, is considered a linking claim and would be joined with one of inventions III and IV, if elected." Because Group III (claim 7) has been elected herein, Applicant requests joinder of claims 6, 9, 10 and 11 for prosecution in the instant application.

Restriction is improper because it does not meet the standard set forth in MPEP § 803. For a proper restriction requirement, MPEP § 803 indicates that the Examiner must show: (1) the inventions are independent or distinct and (2) there would be a serious burden on the Examiner if the restriction is not required. Referring to the second requirement, § 803 recites that "if the search or examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

The Examiner failed to satisfy the first part of the test because the Examiner failed to explain why Group III (claim 7) is independent and distinct from Group IV (claim 8). The Examiner has failed to satisfy the second prong of this test in failing to establish that search and examination of the entire application would be any burden, much less a serious burden, on the Examiner. In total, there are only five claims currently pending in the instant application, and, as admitted by the Examiner, many of the claims originally filed are linking claims that share similar wording. For these reasons, examination of the pending claims cannot be considered an undue burden on the Examiner and that the Examiner's basis for restriction does not meet the criteria set forth by MPEP § 803. Accordingly, the applicants submit that the restriction is improper and must be withdrawn.

II. The Amendments

Pending claims 6, 7, and 9-11 have been amended to more clearly recite the claimed subject matter in more conventional English. No new matter has been introduced with this amendment.


CONCLUSION

In view of the amendments and remarks made herein, Applicant believes that pending claims 6, 7, and 9-11 are in condition for allowance and respectfully request expedient notification of the same.

Respectfully submitted,

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